

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	
Bradford G. Baruh	)	
Application No.: 10/779,471	)	Group Art Unit: 3679
Filed: February 13, 2004	)	Examiner: AARON M.
For: DEVICE AND METHOD FOR	)	DUNWOODY
COUPLING PIPES	)	Appeal No.: Not yet assigned
	)	
	)	
	)	

**AMENDED APPEAL BRIEF**

**Mail Stop APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Primary Examiner dated April 14, 2008 finally rejecting claims 1-6, 11, and 23-30, which are reproduced as the Claims Appendix of this brief.

**I. Real Party in Interest**

The present application is assigned to BGB Enterprises, LLC. BGB Enterprises, LLC is the real party in interest, and is the assignee of Application No. 10/779,471.

**II. Related Appeals and Interferences**

The Appellant legal representative, or assignee, does not know of any other appeal or interferences which will affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

### **III. Status of Claims**

The subject patent application was originally filed with 18 claims. Pursuant to a Restriction Requirement, Claims 7-10 and 12-22 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. During the course of prosecution, new Claims 23-30 were added, and Claims 7-10 and 12-22 were cancelled. Claims 1-6, 11, and 23-30 are presently pending in the application, and all stand rejected.

A Notice of Appeal was filed on May 21, 2008, appealing the Office Action mailed April 14, 2008, finally rejecting Claims 1-6, 11, and 23-30.

### **IV. Status of Amendments**

No Amendments were filed in response to the Office Action mailed April 14, 2008.

### **V. Summary Claimed Subject Matter**

#### **A. Explanation of the Claimed Invention**

The subject matter of the claims presently under appeal, pertain to pipe coupling, which includes an elongated housing defining an elongated bore therein, a stop located on an inner diameter of the housing, a first cylindrical bore extending from the first end to the stop; and a second cylindrical bore extending from the second end to the stop. The cylindrical bores are configured to allow a pipe end to advance into the pipe coupling until reaching the stop. Examples of such a pipe coupling are shown in FIGS. 24-26, and described in paragraphs [0076]-[0080] on pages 19 and 20 of the specification.

**B. Summary of the Claimed Subject Matter**

Three of the appealed claims are in independent format: Claims 1, 11, and 23. Reference is made to FIGS. 24-26. However, the comparison of the claimed subject matter to the specification and drawings is not meant to limit the claim language and is instead done for the convenience of the Board.

Independent Claim 1 recites a pipe coupling (200: FIGS. 24-26; paragraph [0076]) consisting of: an elongated housing (202: FIGS. 24-26; paragraph [0076]) comprising a first end and a second end (204, 206: FIGS. 24-26; paragraph [0076]), the housing defining an elongated bore therein (Paragraph [0076]); a stop (208: FIGS. 24-26; paragraph [0076]) located on an inner diameter (220: FIGS. 24-26; paragraph [0076]) of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing (Paragraph [0076]); a first cylindrical bore (210: FIGS. 24-26; paragraph [0077]) extending from the first end to the stop; and a second cylindrical bore (212; FIGS. 24-26; paragraph [0077]) extending from the second end to the stop, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees (FIGS. 24-26; paragraphs [0077] and [0078]), and wherein each of the cylindrical bores are configured to allow a pipe end to advance into the pipe coupling until reaching the stop. Dependent Claims 2-6 recite the pipe coupling of Claim 1, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 45 degrees to 135 degrees. (FIGS. 24-26; paragraphs [0077] and [0078]).

Claim 11 recites a pipe coupling (200: FIGS. 24-26; paragraph [0076]) consisting of: an elongated housing (202: FIGS. 24-26; paragraph [0076] comprising a first end and a second end (204, 206: FIGS. 24-26; paragraph [0076]), the housing defining an elongated bore therein (Paragraph [0076]); a stop (208: FIGS. 24-26; paragraph [0076]) located on an inner diameter (220: FIGS. 24-26; paragraph [0076]) of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing (Paragraph [0076]); a first cylindrical bore (210: FIGS. 24-26; paragraph [0077]) extending from the first end to the stop; and a second cylindrical bore (212: FIGS. 24-26; paragraph [0077]) extending from the second end to the stop, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees (FIGS. 24-26; paragraphs [0077] and [0078]), and wherein each of the cylindrical bores are configured to allow a pipe end to advance into the pipe coupling until reaching the stop.

Claim 23 recites a pipe coupling (200: FIGS. 24-26; paragraph [0076]) comprising: an elongated housing (202: FIGS. 24-26; paragraph [0076] comprising a first end and a second end (204, 206: FIGS. 24-26; paragraph [0076]), the housing defining an elongated bore therein (Paragraph [0076]); a single stop (208: FIGS. 24-26; paragraph [0076]) located on an inner diameter (220: FIGS. 24-26; paragraph [0076]) of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing (Paragraph [0076]); a first cylindrical bore (210: FIGS. 24-26; paragraph

[0077]) extending from the first end to the stop; and a second cylindrical bore (212; FIGS. 24-26; paragraph [0077]) extending from the second end to the stop, wherein an angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees (FIGS. 24-26; paragraphs [0077] and [0078]). Dependent Claims 24-28 recite the pipe coupling of Claim 23, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 45 degrees to 135 degrees. (FIGS. 24-26; paragraph [0077] and [0078]).

## **VI. Grounds of Rejection to be Reviewed on Appeal**

- A. Claims 1, 5, 6, 11, 23, 27, and 28 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Byrnes, (U.S. Patent No. 6,179,343) in view of Palmer (U.S. Patent No. 413,730).
- B. Claims 2-3 and 24-26 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Byrnes in view of McIlroy (U.S. Patent No. 3,995,888).
- C. Claims 4 and 29-30 are also pending. However, the Office Action mailed April 14, 2008, does not address pending Claims 4 and 29-30.

## **VII. Argument**

### **A. Legal Standards - Obviousness**

Initially, as set forth in 35 U.S.C. § 103(a):

A patent may not be obtained though the invention is not identically disclosed or described ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. (Emphasis added.)

The Office bears the initial burden of establishing a factual basis to support the legal conclusion of obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Office must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

For rejections under 35 U.S.C. § 103(a) that are based upon a combination of prior art elements, the Supreme Court stated in *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007), that "[a]s is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." Rather, as stated in *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir.), "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." See also *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

**B. Claims 1, 5, 6, 11, 23, 27, and 28 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Byrnes, (U.S. Patent No. 6,179,343) in view of Palmer (U.S. Patent No. 413,730.**

**1. Claims 1, 5 and 6:**

Claims 1, 5 and 6 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Byrnes, (U.S. Patent No. 6,179,343) in view of Palmer (U.S. Patent No. 413,730.

Claim 1 recites a pipe coupling consisting of: an elongated housing comprising a first end and a second end, the housing defining an elongated bore

therein; a stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing; a first cylindrical bore extending from the first end to the stop; and a second cylindrical bore extending from the second end to the stop, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees, and wherein each of the cylindrical bores are configured to allow a pipe end to advance into the pipe coupling until reaching the stop.

As explained below, the basis of the rejection is contrary to the recent Board holding in Ex Parte Whalen, Appeal 2007-4423, Application No. 10/281,142 decided 7/23/08. In the Whalen case, the Board held that (1) In re Antonie provides an exception to the rule that optimization of a variable is obvious and (2) a prima facie case of obviousness was not made out because the Examiner "has not pointed to any teaching in the cited references, or provided any explanation based on scientific reasoning, that would support the conclusion that those skilled in the art would have considered it obvious to 'optimize' the prior art compositions by increasing their viscosity to the level recited in the claims." (Whalen at page 14). The Board in Whalen explained that "it must be shown that those of ordinary skill in the art would have had some apparent reason to modify the composition in a way that would result in the claimed composition." (Whalen at page 16). Thus, like the situation in Whalen, a prima facie case of obviousness has not been established in the Final Office Action.

As set forth in the Office Action, Byrnes (mistakenly identified as Muser) "fails to disclose cylindrical bores." Instead, Byrnes relates to a pipe elbow having two parts, each part having an arcuate segment. The arcuate segment of the first part fits sealably into the arcuate segment of the second part. By severing a portion of the arcuate segment of the first part at an angle needed for a specific run of pipe and inserting it into the arcuate segment of the second part, the assembled elbow will conform to the required angle. In addition, a sloped shoulder on the outside of the first part fits in close proximity to the end of the second part to ensure an extension of the first part into the second part in order to meet industry standards for minimum overlap of mating parts. An angled end on the arcuate segment of the second part may also be provided. See abstract.

In contrast to the combination of features as recited in Claim 1, Byrnes does not teach or suggest a pipe coupling having a first cylindrical bore extending from the first end to the stop; and a second cylindrical bore extending from the second end to the stop. Rather, in Byrnes each segment is arcuate (i.e., "to bend like a bow"). Merriam-Webster's Collegiate Dictionary, Tenth Edition, defines cylindrical as "relating to or having the form or properties of a cylinder." Meanwhile, a cylinder is defined as "a: the space traced by a straight line moving parallel to a fixed straight line and intersecting a fixed planar closed curve b: the space bounded by a cylinder and two parallel planes cutting all its elements." Thus, based on the definition of cylindrical, a pipe elbow having two parts, each part having an arcuate segment as shown in Byrnes, does not teach or suggest a cylindrical bore. (Emphasis added).

In addition, Byrnes does not show that one of ordinary skill in the art would have some apparent reason to modify the pipe coupling of Byrnes to make a pipe



coupling as recited in Claim 1 having a cylindrical bore. As set forth in Byrnes, the invention is in the field of pipe fittings, specifically pipe elbows and pipe connections, and wherein a need exists "for a pipe elbow which can be adapted to whatever angular displacement is required for a piping installation, and it is this need which the invention addresses." Col. 1, lines 38-41.

Meanwhile, Palmer relates to a tent, which may be folded into a compact bundle for transportation and when desired for use can be spread and set up in an expeditious manner without the aid of "guy ropes." As shown in Palmer, Fig. 2 represents a longitudinal section of angle socket-piece connected to pieces of the tent-frame, drawn on an enlarged scale.

In contrast to the combination of features as recited in Claim 1, neither Byrnes nor Parker disclose a pipe coupling having an elongated housing comprising a first end and a second end, the housing defining an elongated bore therein; a stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing; a first cylindrical bore extending from the first end to the stop; and a second cylindrical bore extending from the second end to the stop.

Rather, in Byrnes each segment is arcuate (i.e., "to bend like a bow"). Meanwhile, in Parker, each piece is an angle socket-piece, which does not include a housing defining an elongated bore therein nor is the stop located on an inner diameter of the housing such that the distance from the stop to one of the first and the second ends is at least two times the distance from the stop to the other of the

first and second end of the housing as recited in Claim 1. Furthermore, Byrnes does not show that one of ordinary skill in the art would have some apparent reason to modify the pipe coupling of Byrnes to make a pipe coupling as recited in Claim 1. Accordingly, for the reasons set forth above, Claim 1 should be allowable.

Since Claim 1 is patentable for the reasons enumerated above, Claims 5 and 6 are also patentable. Accordingly, reversal of the rejection of Claims 5 and 6 is respectfully requested. Claims 5 and 6 stand or fall with independent Claim 1.

**2. Claim 11:**

Claim 11 stands rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Byrnes, (U.S. Patent No. 6,179,343) in view of Palmer (U.S. Patent No. 413,730).

Claim 11 recites a pipe coupling consisting of: an elongated housing comprising a first end and a second end, the housing defining an elongated bore therein; a stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing; a first cylindrical bore extending from the first end to the stop; and a second cylindrical bore extending from the second end to the stop, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees, and wherein each of the cylindrical bores are configured to allow a pipe end to advance into the pipe coupling until reaching the stop.

As set forth above, in contrast to the combination of features as recited in Claim 11, neither Byrnes nor Parker disclose a pipe coupling having an elongated

housing comprising a first end and a second end, the housing defining an elongated bore therein; a stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing; a first cylindrical bore extending from the first end to the stop; and a second cylindrical bore extending from the second end to the stop.

Rather, in Byrnes each segment is arcuate (i.e., "to bend like a bow"). Meanwhile, in Parker, each piece is an angle socket-piece, which does not include a housing defining an elongated bore therein nor is the stop located on an inner diameter of the housing such that the distance from the stop to one of the first and the second ends is at least two times the distance from the stop to the other of the first and second end of the housing as recited in Claim 11. Furthermore, as set forth above, Byrnes does not show that one of ordinary skill in the art would have some apparent reason to modify the pipe coupling of Byrnes to make a pipe coupling as recited in Claim 11. Accordingly, for the reasons set forth above, Claim 11 should be allowable.

### **3. Claims 23, 27 and 28:**

Claims 23, 27 and 28 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Byrnes, (U.S. Patent No. 6,179,343) in view of Palmer (U.S. Patent No. 413,730).

Claim 23 recites a pipe coupling comprising: an elongated housing comprising a first end and a second end, the housing defining an elongated bore therein; a single stop located on an inner diameter of the housing, the stop located between

the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing; a first cylindrical bore extending from the first end to the stop; and a second cylindrical bore extending from the second end to the stop, wherein an angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees.

As set forth above, in contrast to the combination of features as recited in Claim 23, neither Byrnes nor Parker disclose a pipe coupling having an elongated housing comprising a first end and a second end, the housing defining an elongated bore therein; a stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing; a first cylindrical bore extending from the first end to the stop; and a second cylindrical bore extending from the second end to the stop.

Rather, in Byrnes each segment is arcuate (i.e., "to bend like a bow"). Meanwhile, in Parker, each piece is an angle socket-piece, which does not include a housing defining an elongated bore therein nor is the stop located on an inner diameter of the housing such that the distance from the stop to one of the first and the second ends is at least two times the distance from the stop to the other of the first and second end of the housing as recited in Claim 23. Furthermore, as set forth above, Byrnes does not show that one of ordinary skill in the art would have some apparent reason to modify the pipe coupling of Byrnes to make a pipe coupling as

recited in Claim 23. Accordingly, for the reasons set forth above, Claim 23 should be allowable.

Since Claim 23 is patentable for the reasons enumerated above, Claims 27 and 28 are also patentable. Accordingly, reversal of the rejection of Claims 27 and 28 is respectfully requested. Claims 27 and 28 stand or fall with independent Claim 23.

**C. Claims 2-3 and 24-26 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Byrnes in view of McIlroy (U.S. Patent No. 3,995,888).**

Claims 2-3 and 24-26 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Byrnes in view of McIlroy (U.S. Patent No. 3,995,888).

Claims 2 and 24 the pipe coupling of Claims 1 and 23, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 45 degrees.

Claims 3 and 25 recite the pipe coupling of Claims 1 and 23 respectively, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 60.

Claim 26 recites the pipe coupling of Claim 23, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 90.

McIlroy relates to a flexible pipe connector having a plurality of segmented sections fabricated along precast or scribed frangible lines.

For the reasons set forth above as to Claims 1 and 23, and further since Claims 2, 3, and 24-26 are dependent from Claims 1 and 23, Claims 2, 3, and 24-26

should be allowable. Claims 2, 3, and 24-26 stand or fall with independent Claims 1 and 23, respectively.

**D. Claims 4 and 28-30:**

Claims 4 and 29-30 are also pending. However, the Office Action mailed April 14, 2008, does not address pending Claims 4 and 29-30.

Claim 4 recites the pipe coupling of Claim 1, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 90.

Claims 29-30 recite the pipe coupling of Claim 1, wherein the stop is a single stop located on the inner diameter of the housing, and the pipe coupling of Claim 11, wherein the stop is a single stop located on the inner diameter of the housing, respectively.

For the reasons set forth above, and further since Claims 4 and 29-30 are dependent from Claims 1 and 11, Claims 4 and 29-30 should be allowable. Claims 4, and 29-30 stand or fall with independent Claims 1 and 11, respectively.

**VIII. Claims Appendix**

See attached Claims Appendix for a copy of the claims involved in the appeal.

**IX. Evidence Appendix**

No Evidence Appendix is attached, because no evidence relied upon by Appellant is identified.

**X. Related Proceedings Appendix**

No Related Proceedings Appendix is attached, since no Related Proceedings are identified in Section II, supra.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY LLP

Date November 21, 2008

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## VIII. CLAIMS APPENDIX

### The Appealed Claims

1. A pipe coupling comprising:
  - an elongated housing comprising a first end and a second end, the housing defining an elongated bore therein;
  - a stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing;
  - a first cylindrical bore extending from the first end to the stop; and
  - a second cylindrical bore extending from the second end to the stop, wherein an angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees, and wherein each of the cylindrical bores are configured to allow a pipe end to advance into the pipe coupling until reaching the stop.
2. The pipe coupling of Claim 1, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 45 degrees.
3. The pipe coupling of Claim 1, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 60.
4. The pipe coupling of Claim 1, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 90.
5. The pipe coupling of Claim 1, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 120 degrees.



6. The pipe coupling of Claim 1, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 135 degrees.

11. A pipe coupling consisting of:

an elongated housing comprising a first end and a second end, the housing defining an elongated bore therein;

a stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing;

a first cylindrical bore extending from the first end to the stop; and

a second cylindrical bore extending from the second end to the stop, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees, and wherein each of the cylindrical bores are configured to allow a pipe end to advance into the pipe coupling until reaching the stop.

23. A pipe coupling comprising:

an elongated housing comprising a first end and a second end, the housing defining an elongated bore therein;

a single stop located on an inner diameter of the housing, the stop located between the first end and the second ends of the housing, wherein a distance from the stop to one of the first and second ends is at least two times a distance from the stop to the other of the first and second end of the housing;

a first cylindrical bore extending from the first end to the stop; and

a second cylindrical bore extending from the second end to the stop, wherein an angle between the first cylindrical bore and the second cylindrical bore is about 15 degrees to about 165 degrees.

24. The pipe coupling of Claim 23, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 45 degrees.

25. The pipe coupling of Claim 23, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 60.

26. The pipe coupling of Claim 23, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 90.

27. The pipe coupling of Claim 23, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 120 degrees.

28. The pipe coupling of Claim 23, wherein the angle between the first cylindrical bore and the second cylindrical bore is about 135 degrees.

29. The pipe coupling of Claim 1, wherein the stop is a single stop located on the inner diameter of the housing.

30. The pipe coupling of Claim 11, wherein the stop is a single stop located on the inner diameter of the housing.

## IX. EVIDENCE APPENDIX

None

## **X. RELATED PROCEEDINGS APPENDIX**

None